UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,330	01/08/2001	Yueh-O Yu	JCLA6008	6728

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EXAMINER
VU, TUAN A

ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 April 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-29</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-29</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the Applicant's response filed 4/25/2005.

As indicated in Applicant's response, claims 1, 7, and 16 have been amended. Claims 1-

29 are pending in the office action.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> Note: 35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

3.   Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wells et al.,

USPubN: 2003/0228912.

As per claim 1, Wells discloses a method for updating personalized products (e.g.

customized - pg. 6, para 0043 – Note: target devices being verified with predetermined signature

or identification, address – see para 0036, 0040, 0043 – combined with the inherent ownership of

the gaming devices by a person – see *individual casino or similar locations* – is equivalent to

product being personalized, i.e. providing specific programs to certain authenticated target

devices owned by a person in whose name such target devices are being updated), comprising:

downloading a personalized program code from a storage device (e.g. *server 466* - Fig. 4);

receiving the personalized program code or data code by a transmission medium, and then transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4); and

programming the personalized program code or data code received from said transmission medium into said programmable personalized product for updating the function or data therein (e.g. Figs. 1 – 5; pg. 6, para 0043-0046);

wherein the personalized program code or data code is suitable of being further designed and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a gaming terminal, standardization of programming* - pg. 6 para 0043 – Note: code data being changed or feature being added by game operators reads on data code suitable of being further developed by user; see *incorporated by reference* application 09/172787, or USPN 6,488,585: col. 5, lines 12-33 – Note: code being refurbished for release at a developers machine reads on designed by user of data code or personalized program; *repairing, updating* - col. 9, lines 27-40 -) of the personalized product at option of the user;

and is suitable of being uploaded back to the storage device (e.g. Fig. 1A; see para 0035: *incorporated by reference* -US Application: GAMING DEVICE IDENTIFICATION METHOD and APPARATUS, application 09/172787, now patented USPN: 6,488,585: col. 5, lines 12-33; *uploading* - col. 9, lines 27-40 – Note: code being refurbished for release at a developers machine and transferred for verification and storage to a central database reads on upload; and

gaming regulating personnel sending game trouble report back to central jurisdiction reads on

upload).

As per claim 2, Wells discloses a storage device being a hard disk, a CD-ROM (Fig. 4).

As per claim 3, Wells discloses personalized program code or data code being provided

by a manufacturer (Fig. 4-5; *game manufacturers* - pg. 6, para 0043).

As per claim 4, Wells discloses that the personalized program code being developed and

provided by a user (e.g. pg. 6, para 0043; *customer order 472* – Fig. 4; *information file* - Fig. 5;

laptop 128, game controller board – Fig. 1A; pg. 3, para 0025, 0028 – Note: programming

information enabling user to program and control the security of the download and activation of

the downloaded reads on code being developed and provided by a user).

As per claim 5, Wells discloses a transmission medium being a personal computer and a

hand-held device (e.g. Fig. 4; pg. 2, para 0017).

As per claim 6, Wells discloses transmission through an interface being a serial port

interface (e.g. Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to

gaming device implicitly discloses a serial/parallel port or USB port).

As per claim 7, Wells discloses a method for updating personalized products,

comprising:

downloading a personalized program code from a web site (e.g. *network* – pg. 3, para

0030; *server 466* - Fig. 4 – Note: network central server computer and workstation for

distribution of game products implicitly discloses communication between computers and web

sites)

receiving the personal program code or data code by a transmission medium, and then

transmitting the code to a programmable personalized product (e.g. *local server 114* – Fig. 3;

Terminal 488 – Fig. 4); and

programming the personalized code or data code received from said transmission

medium into said programmable personalized product for updating the function or data therein

(e.g. Figs. 1 – 5; pg. 6, para 0043-0046);

wherein the personalized program code or data code is suitable of being further designed

and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a*

gaming terminal, standardization of programming -pg. 6 para 0043; see *incorporated by*

reference application 09/172787, or USPN 6,488,585: col. 5, lines 12-33; *repairing, updating* -

col. 9, lines 27-40) of the personalized product at option of the user;

and is suitable of being uploaded back to the website or storage device (e.g. Fig. 1A; see

para 0035: *incorporated by reference* -US Application: GAMING DEVICE IDENTIFICATION

METHOD and APPARATUS, application 09/172787, now USPN: 6,488,585: col. 5, lines 12-

33; *uploading* - col. 9, lines 27-40 – Note: code being refurbished for release at a developers

machine and transferred for verification and storage to a central database reads on upload; and

gaming regulating personnel sending game trouble report back to central jurisdiction reads on

upload).

As per claim 8, Wells discloses communication between the server and a transmission

medium via a network of wireless or wired transmission system (e.g. *lan line* - pg. 3, para 0030;

pg. 7, para 0051).

As per claim 9, Wells discloses a transmission system utilizing one modem (e.g. pg. 3, para 0030; link *324* – Fig. 3).

As per claim 10, refer to rejection of claim 5.

As per claim 11, Wells discloses a wireless link (e.g. pg. 3, para 0030).

As per claim 12, Wells does not explicitly disclose a wireless transmission system consisting of GSM, CDMA, GPRS; but discloses a wireless link and a handheld device (pg. 2, para 0017; pg. 3, para 0030), hence has implicitly discloses a wireless protocol and standard associated with the use of handheld device.

As per claim 13, Wells discloses transmission of personalized program code or data code to the programmable personalized product through a serial port or a USB port (Fig. 4; *port* – pg. 3, para 0030 – Note: communications port from computer to gaming device implicitly discloses a serial/parallel port or USB port).

As per claims 14-15, see claims 3-4 respectively.

As per claim 16, Wells discloses a device for updating personalized products, comprising:

an input/output end (e.g. Fig. 1A – Note: input to the local controller or laptop, output from the game controller board into features of the game, like video, audio output);

a programmable memory (e.g. *EEPROM* - pg. 3, para 0025), which is programmed with a personalized program code or data code through the input/output end; and

a personalized function circuit (e.g. *gaming terminal* - Fig. 1A) which updates functions and information according to the personalized program code or the data code stored in said programmable memory;

wherein the personalized program code or data code is suitable of being further designed

and developed personally by a user (e.g. *changing features, upgrading, adding ... feature to a*

gaming terminal, standardization of programming -pg. 6 para 0043; see *incorporated by*

reference application 09/172787, or USPN 6,488,585: col. 5, lines 12-33; *repairing, updating* -

col. 9, lines 27-40) of the personalized product at option of the user;

and is suitable of being uploaded back to the website or storage device (e.g. Fig. 1A; see

para 0035: *incorporated by reference* -US Application 09/172787, now USPN: 6,488,585: col.

5, lines 12-33; *uploading* - col. 9, lines 27-40).

As per claim 17, Wells discloses a transmission medium to receive and transmit the

personalized program code or data code (e.g. *local server 114* – Fig. 3; *Terminal 488* – Fig. 4).

As per claims 18-19, see claims 3-4, respectively.

As per claims 20 and 21, Wells discloses a control circuit for producing control

functions (e.g. *laptop 128, game controller board* – Fig. 1A); and that the control circuit

generates voltage and control signal during programming the programmable memory (e.g. pg. 7,

para 0053; pg. 3, para 0025; Fig. 2 – Note: checking communications correctness and using of

laptop to control the download security checking/memory programming is equivalent to

providing voltage and control signal during programming of gaming device).

As per claim 22, Wells discloses circuit for decoding a personalized program (e.g. Fig.

1B; Fig. 3 – Note: processor in gaming terminal with embedded processor is equivalent to having

circuitry to decode instructions of downloaded personalized program)

As per claim 23, Wells discloses control circuit for transmission of personalized data

code in the programmable memory (e.g. pg. 3, para 0028; Fig. 1a, 4).

As per claims 24-25, see Wells (Fig. 4, Fig. 1B; Fig. 3)

As per claim 26, Wells discloses personalized product being a gaming terminal.

As per claim 27, see Wells (*EEPROM* - pg. 3, para 0025).

As per claim 28-29, Wells discloses a program code and a data code within the programmable memory (e.g. pg. 6, *software information, installed programs* – pg. 0043; *data which defines* – para 0046 – Note: installed data or programs reads on program and data being part of the programmable EEPROM of terminals).

Response to Arguments

4.   Applicant's arguments filed 4/25/2005 have been fully considered but they are not persuasive. Following are the Examiner's reply to the corresponding points raised in the Applicant's remarks.

Applicant has submitted that the Wells do not teach 'personalized products' and that Wells does not teach a 'way for the user to redesign or further develop ... suitable for uploading back ... to be accessible for other users (Appl. Rmrks, middle para - pg. 9).

First, the claim only recites 'personalized products' but fail to specifically define what constitutes the fact of being 'personalized'. A broad and reasonable interpretation has been adopted such that limitation is perceived as a product destined for delivery to a person owning a device or to the device owned by such person, such delivered product being personalized for the owner of the target device recipient. To that effect, the rejection has been directed to point to portions showing that the delivered product is perceived as a personalized product. Further, Wells's method is geared toward making resources-efficient update to game terminals, and the inherent ownership of those terminals in gaming establishments by a person entails that the

process of delivering the product is according to the specifications or preferences (as in

customized –see portions in rejection; pg. 6 para 0043) given by the establishment or proprietor

of those gaming devices, as opposed to the rationale that the gaming devices as disclosed by

Wells are merely there to be maintained and updated solely for a general public use, as in a non-

lucrative enterprise. The sole fact that the gaming devices belong to a gaming location signifies

that a person with a intention to run business with profits is behind the process of updating so

that the devices are operable in a desirable configuration in a most resources-efficient or

profitable way, hence according to some customizing as being pointed out in the rejection. The

intention of Wells is to distribute a gaming software to the devices belonging to owner of game

terminals; and such game product reads on of personalized products throughout its lifecycle,

from the point where they are designed, stored for release, verified, downloaded and further

manipulated by the recipient of the gaming establishment, maintenance operators or casino

operator and finally gaming users. The claim (e.g. claim 1) only calls for the steps downloading,

receiving transmitting and programming. Nowhere in the claim is there any specific description

that would narrow the concept evolving how personalized those products are or what

'personalized' consists of. A broad interpretation has been reasonably applied; and Wells is seen

as meeting this limitation.

Second, Wells reference incorporates the teaching of US Application 09/172,787 now

patented as USPN: 6,488,585. In the rejection, it has been pointed to parts that read on data code

being designed and further developed by user of the personalized products. As set forth, there is

no distinction between program code being developed at a developers machine for updating its

internal functionality leading to a upgraded release and the same product being downloaded to a

casino operator for the latter to change or add features to its gaming context because it is the

same personalized product by intent, regardless of its life cycle stage. The rejection has shown

where the limitation as to 'designed or further developed' has been read on by Wells; and where

the limitation as to 'uploaded' has been met by Wells. The claim is broad on 2 counts. First, the

claim is giving alternative about what exactly is being *further developed* or *uploaded*: that being

either software program or data code. A data code is data that is encoded for transmission or for

interpretation by a execution or receiving machine; and the information accompanying Wells'

product downloaded into the gaming device memory (EPROM) and being subject to further

modification by the gaming operators read on data code (see Wells pg. 6 para 0043) being

further developed. Besides, when a developer who is recipient as to receive program code from

a release database (Fig. 1A) so to further make changes to the software product and upload its

latest version for restorage and subsequent distribution, the receiving for effectuation changes to

the product reads on what is recited as 'program code or code data suitable of being ... by a user

... at option of the user', notwithstanding the inherent concept that a code designer has to be an

user for verifying code functionality. Second, the claim recites 'suitable for'. This *personalized*

product is only *suitable for*, meaning that either its internal data code stays unchanged as

downloaded, or necessarily has to go through some refurbishing or re-modifying process, i.e. the

product encompasses data ready to be changed or not changed at all. Either scenario fits the

context of downloading and game activating by Wells. Wells teaches product game software

upon being stored in the EPROM and least likely to require manual change; and also teaches data

stored with this software that can be further modified by casino operators, one of which would

result in data being uploaded back to verification servers. The design engineering upon

receiving the code version from the database central can effect changes or not effecting at all,

and that equally reads on *suitable for*. The rejection has been specific about how the claim has

been interpreted and mapped limitation per limitation against Wells pertinent teachings.

For the above reasons, the claims will stand rejected as set forth in the Office Action.

Abstract

5.   Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a
separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed
150 words in length since the space provided for the abstract on the computer tape used by the
printer is limited. The form and legal phraseology often used in patent claims, such as "means"
and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist
readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the
title. It should avoid using phrases which can be implied, such as, "The disclosure concerns,"
"The disclosure defined by this invention," "The disclosure describes," etc.

As per the present abstract, the 150 words limit rule has not been complied to. Corrective

action is required.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The

examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is

assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before

using) or 703-872-9306 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VAT
June 6, 2005

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